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EXAMINER

RANKINS, WILLIAM E

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/645,060
Filing Date: August 21, 2003
Appellant(s): DURO-EMANUEL ET AL.

Alison B. Weisberg
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 04/11/2011 appealing from the Office action mailed 10/27/2010.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:
35-42, 51-66 and 70-75.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact

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terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 35-42, 51-66 and 70-75 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement as disclosed in the office action dated 11/16/2008 and maintained in subsequent actions. For example, independent claim 35 recites:

A system comprising:

Memory operable to store at least one program; and

at least one processor communicatively coupled to the memory, in which the at least one program, when executed by the at least one processor, causes the at least one processor to perform a method comprising:

providing liquidity to a financial transaction in which a term note and a money market note are issued by

upon receiving a payment for principal of the term note, crediting the payment to principal of the money market note if the principal of the money market note is not fully credited, and

crediting the payment to principal of the term note if the principal of the money market note is not fully credited,

wherein the term note and the money market note have a same credit risk rating.

A review of Para's. 0018, 0019 and 0024 of the applicants' published specification discloses that "the credit... may be represented by a journal entry for an account, which in turn, may be represented in an electronic format." and "Money market note and term note may be embodied...in an electronic form, such as a data record or file associated with an account.

The examiner asserts that nowhere in the specification is there a representation of a system comprising memory and at least one processor as recited in claim 35 and similarly recited in claims 51 and 59. As a result, per the guidance provided in the MPEP, the examiner has determined that possession of the invention, as claimed, has not been shown by the original disclosure.

(10) Response to Argument

Applicant's arguments filed 04/11/2011 have been fully considered but they are not persuasive. The examiner has rejected claims 35-42, 51-66 and 70-75 in previous office actions under 35 U.S.C. 112, 1st Para. for failure to comply with the written description requirement. In order to overcome previous rejections under 35 U.S.C. 101 the applicant has amended the claims to recite systems comprising memory to store at least one program and at least one processor coupled to the memory that when executed by the processor cause the computer to perform a method, and a computer readable storage medium having stored thereon computer executable instructions that configure the computer to perform a method. As stated previously, the examiner finds

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that the specification does not disclose a system comprising memory operable to store at least one program and at least one processor coupled to the memory which when executed by the processor causes the processor to perform the method of the applicable claims. The examiner asserts that the specification also does not disclose a computer readable medium having stored thereon computer executable instructions that configure the computer to perform the method of the applicable claims.

In response to the examiners findings the applicant argues that the claims comply with 35 U.S.C. 112, 1st Para. written description requirement according to:

MPEP 2163.02 – The subject matter of the claim need not be described literally(i.e. using the same terms or in haec verba) in order for the disclosure to satisfy the written description requirement.

The examiner asserts that MPEP 2163.02 also states:

If a claim is amended to include subject matter , limitations, or terminology not present in the application as filed, involving a departure from, addition to, or deletion from the disclosure of the application as filed, the examiner should conclude that the claimed subject matter is not described in that application. This conclusion will result in the rejection of the claims affected under 35 U.S.C. 112, 1st Paragraph - description requirement, or denial of the benefit of the filing date of a previously filed application, as appropriate.

Therefore the applicant has not fully considered the guidelines under MPEP 2163.02 and the examiners position is maintained.

The applicant also contends that according to MPEP 2161.01 that the specification must show that the applicant was in possession of the claimed invention in order to satisfy the written description requirement.

The examiner notes that MPEP 2161.02 also states that "The requirements for sufficient disclosure of inventions involving computer programming are the same as for all inventions sought to be patented. Namely, there must be an adequate written description, the original disclosure should be sufficiently enabling to allow one to make and use the invention as claimed, and there must be presentation of a best mode for carrying out the invention. It should be recognized that sufficiency of disclosure issues in computer cases necessarily will require an inquiry into both the sufficiency of the disclosed hardware as well as the disclosed software due to the interrelationship and interdependence of computer hardware and software." The examiner notes that neither computer hardware nor software is disclosed in the specification as originally filed.

The applicant also draws upon MPEP 2163.02 for support as "The test for sufficiency of support in a parent application is whether the disclosure relied upon "reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter."

The examiner notes that MPEP 2163.02 goes on to state that "An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention."

The examiner also notes that MPEP 2163.03 identifies typical circumstances where adequate written description should be questioned, including amendments affecting a claim, as is the case here. "An amendment to the claims or the addition of a new claim must be supported by the description of the invention in the application as filed. *In re Wright*, 866 F. 2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989)."

The examiner notes the MPEP 2163.04 establishes the burden on the examiner with regard to the written description requirement. "A description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption. The examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description. The examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. *Wertheim*, 541 F.2d at 263, 191 USPQ at 97. In making a statement of rejection. In rejecting a claim, the examiner must set forth express findings of fact which support the lack of written description conclusion. These findings should:

(A) Identify the claim limitations at issue; and

(B) Establish a *prima facie* case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed. A simple statement such as "Applicant has not pointed out where the new (or amended) claim is supported, nor does there appear to be a written description of the

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claim limitation_____ ' in the application as filed." May be sufficient where the claim is a new or amended claim, the support for the limitation is not apparent, and applicant has not pointed out where the limitation is supported.

In addition to citing specific portions of the MPEP to rebut the examiners rejection the applicant also cites portions of the specification which the applicant believes reasonably conveys to one of ordinary skill in the art that possession of the invention is shown in the original disclosure. The applicant cites page 4, lines 16-20 which define a "collection" as a receipt of a payment from a payor and represents a transfer of money, but does not literally involve the movement of cash. The transfer may be represented as a journal entry, which in turn, may be represented in an electronic format, e.g. an electronic funds transfer.

First, the examiner asserts that the term collection is not used in the claims and therefore this section of the specification does not apply to the rejection at issue. Secondly, Assuming that the cited portion of the specification is applicable in some way to rejections at issue, the claims do not comprise a payment receiving step. For example, claim 35 states that the method comprises "providing liquidity...by , upon receiving a payment..." The act of receiving a payment is not a step in the process. The process begins after the payment is received.

The applicant cites page 4, lines 21-25 which define a "credit" as an allocation of money to, or for the benefit of, an entity and need not be accompanied by an actual

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movement of cash but may be represented as a journal entry, which in turn, may be represented in an electronic format.

The examiner asserts that the collection and credit may be represented in an electronic format such as an electronic funds transfer but these steps are not necessarily performed exclusively by a machine. There may be significant human involvement in the process steps and the specification leaves that inquiry unresolved.

The applicant also cites pg. 5, lines 11-17 where a money market note and a term note may be embodied in an electronic form.

First, the examiner asserts that the embodiment of the notes has no bearing on the rejected claims at issue as there is no specific limitation in the claims regarding how the notes may be represented.

Secondly, the examiner asserts that this section of the specification may be referring to dematerialized securities which are simply an electronic representation of a security which makes tangible certificates unnecessary.

Finally, the examiner asserts that because certain actions, namely collecting, crediting and representation of securities can be performed electronically does not lead to the necessity for a system comprising memory, a processor and computer readable instructions to perform the steps of providing liquidity to a financial transaction by determining if a note is fully credited and if so redirecting the payment. The applicant argues that their interpretation of the originally filed disclosure would be obvious to one of ordinary skill in the art. What may be obvious to one of ordinary skill in the art is not the test. *Lockwood vs. Anderson*, 41USPQ2d@1996. applicant has the burden of proof

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of showing that a person of skill in the art would have understood, at the time the patent application was filed, that the description requires the limitation. Hyatt, 47 USPQ2d @ 1131.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/W. R./

Examiner, Art Unit 3684

04/19/2011

Conferees:

/Jason B Dunham/

Supervisory Patent Examiner, Art Unit 3684

Vincent Millin/vm/

Appeals Conference Specialist

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